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IN THE

Supreme Court of the United States

OCTOBER TERM 1972

NO. 72-1161

GENERAL MOTORS CORPORATION,
Petitioner,

v.

DEVEX CORPORATION, et al.,
Respondents.

BRIEF IN OPPOSITION TO THE PETITION

Counterstatement of the Case

1. Summary Statement.

This is an ordinary patent infringement case based upon a patent which expired four years ago. The Third Circuit decision which Petitioner now seeks to have reviewed [A-54]* decides no question of public importance but only that Petitioner is liable for its infringements occurring prior to the expiration date.

Petitioner's Question One (Pet. p. 2) is a contrived one which is not actually present in the case. The only issue in this, the Third Circuit proceeding [A-54], is whether Petitioner (hereinafter "GM") infringed the patent; infringement was never tried and decided in

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*Citations in the form "[A- . . .]" are to pages of the Appendix bound with the Petition.

the Seventh Circuit. There is no conflict (not even a philosophical one) because the decisions of the Seventh Circuit, and the Third Circuit all hold that the claim must be given the same interpretation for infringement purposes as for validity purposes, and the Third Circuit decision is based upon that interpretation.

Petitioner's Question Two (Pet. p. 2) is also a contrived one which is based on non-existent premises. The validity decision herein [A-13] did not depart from but was in strict accord with the settled law pertaining to patent specifications and claims. Certiorari was denied nine years ago; 357 U.S. 971. The validity decision is not in conflict with the decisions in the Second and Fifth Circuits cited in the Petition (pp. 15-17). It has no similarity, factual or decisional, to the Sixth Circuit case mentioned in the Petition (p. 14).

2. The Patented Invention; Its Nature and Advantages.

The patent in suit is Henricks Patent Re. 24,017 (Ptfs. Ex. 1; Vol. 1, p. 1). It is a reissue of Patent 2,588,234 dated March 4, 1952, and hence expired on March 4, 1969. This lawsuit therefore continues only for the purposes of an accounting for infringements by Petitioner prior to the expiration date [A-55, fn. 1].

The invention covered by the claim in suit [Claim 4; A-13, fn. 1] is for a process of cold working ferrous metal by a die or dies wherein a phosphate coating is formed on the surface of the metal workpiece and a fixed (i.e., dried) film of specified character and composition is superposed, all prior to cold working the metal.

One objective of the Henricks process, the attainment and maintenance of a lubricity effective to minimize scoring and galling of the workpiece and the die during drawing, had long been sought but the most effective of the prior processes — the so-called "German Process"—had the inherent defect that it caused the deposit of a stubborn insoluble residue on the workpiece and presented a difficult cleaning problem, especially if the formed product (e.g. an automobile bumper) had to be electroplated [A-56].

The Henricks process markedly increased lubricity, with resulting increase in tool and die life and freedom from damage to the workpiece, and inhibited the deposit of insoluble residues [A-55, 56]. This new combination brought about a revolutionary change in bumper manufacture with great savings in time and labor (Vol. 7 of the Printed Appendix transmitted as part of the certified Record to this Court; pp. 2997, 3014-15, 3096-97, 3112, 3120, 3168, 3182-83, 3188-89, 3198).

3. Summary of the Litigations.

This lawsuit and the companion *Houdaille* case [A-20] were commenced in 1956 in the Northern District of Illinois. They were there consolidated for trial of the common issue of validity. The district court held the claim invalid on various grounds [A-5]. The Court of Appeals (7 Cir.) reversed and held the patent valid [A-13]. Certiorari was denied January 6, 1964; 357 U.S. 971.

The cases were then separated for the trial of their separate infringement issues. The *Houdaille* case re-

mained in the Seventh Circuit. This, the *GM* case, was transferred to the District of Delaware.*

Subsequent to the transfer of the *GM* case to Delaware the plaintiffs moved for summary judgment in each of the cases. In each case, the motion was predicated on a showing that the accused process responded literally to the claim; cf. *Graver II,* p. 607.** In each case, the defendant claimed that in its commercial practices it did not achieve the unexpected advantages that made the Henricks combination patentable and that in any event this was still a genuine issue of material fact.

Summary judgment was denied in this, the *GM* case [A-36]. The district court invoked the rule of *Graver II* (p. 608), "If an allegedly infringing process falls within the literal language of the claim, but can be shown to operate in a different manner from the patented process then there is no infringement" [A-37, 38]; and held that "genuine and significant issues" regarding the response of GM's practices to the claim remained to be tried [A-38].

Summary judgment was granted in the *Houdaille* case but the Court of Appeals reversed [A-20] for reasons essentially the same as those stated by the Delaware District Court. It concluded its opinion by saying [A-28]:

> "We decide nothing more than that summary judgment was improvidently allowed. Anything we

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*GM opposed the transfer on venue grounds. GM's contention was rejected both by the Delaware District Court [A-21, at 23-4] and the Court of Appeals [A-54, at 59] and is no longer pressed.

***Graver Mfg. Co. v. Linde Co.,* (1950) 339 U.S. 605.

have said is not to be construed as a resolution of any factual issue. We have attempted only to point out some of the issues of material fact which, in our judgment, entitle the parties to a hearing."

The *Houdaille* case was thereafter settled without trial. The result is that no question of infringement of the Henricks patent has ever been tried or decided in any case but this one.

The *GM* infringement issue was tried in the Delaware District Court and decided in GM's favor [A-39]. GM's defense was that it followed the essential teachings of the "German Process" and did not achieve the unexpected results that made the Henricks combination patentable. The district court found that the accused processes were "effective, beneficial and an improvement over earlier solutions to [GM's] lubricating problems" and that "they utilize some of the learning upon which the patent was based" [A-41] but was persuaded by expert testimony, most of it based on *ex parte* laboratory tests, that the plaintiffs had not established infringement by a "preponderance of evidence" [A-52, 53].

The Court of Appeals, citing agreed and undisputed facts of record establishing that GM did not follow the German Process in its actual commercial practices and did achieve the unexpected results that made the Henricks combination patentable, held that the evidence preponderated in the plaintiffs' favor and reversed [A-54, at 56-59].

In so doing, the Third Circuit did not give the patent a broader scope for infringement purposes than the Seventh Circuit had given it for validity purposes

(cf. Pet. pp. 11-12, 13-14), nor did it enforce the Henricks patent against "a different process which has not been held patentable" or "prohibit the public from free use of unpatentable processes", as Petitioner erroneously asserts (Pet. p. 11).

4. Petitioner no longer disputes that the Henricks claim satisfies the statutory conditions of utility, novelty and non-obviousness.

All of the standard defenses—lack of utility (Sec. 101), lack of novelty (Sec. 102), obviousness (Sec. 103) and indefiniteness of the claim (Sec. 112)—were invoked, and all these issues were resolved in plaintiffs' favor in the Seventh Circuit decision [A-13]. The validity decision [A-13] antedated *Graham v. John Deere* and *United States v. Adams* (383 U.S. 1 and 39) but the treatment of these issues comports fully with the *rationale* of those decisions.

(a) On the "utility" or "combination v. mere conjunction" issue (Sec. 101) plaintiffs have invoked the "new result" rule of *A. & P. Tea Co. v. Supermarket Corp.*, (1950) 340 U.S. 147, from the beginning [A-4, fn. 16; A-16]. The trial court recognized that the patent in suit had made a stride forward in the art but apparently thought it was not sufficient to warrant a patent monopoly [A-18]. Pointing to laboratory tests but more significantly to results achieved in actual commercial use, the Court of Appeals held that Henricks' advance warranted a patent [A-16] particularly since the Patent Office had considered the most pertinent art and had found patentable invention over it [A-17]. The Third Circuit, citing *Supermarket,* expresses its full accord on the legal principle involved [A-55, 56] and goes

on to show that GM achieved the unexpected results that made the Henricks combination patentable [A-56, 57, 58].*

(b) The Sec. 102 defense was based upon thirty-one prior patents and a number of alleged prior public uses. The Court of Appeals held that none of the thirty-one prior patents anticipated [A-17] and that the defense of prior public use had not been made out [A-18, 19].

(c) In disposing of the Sec. 103 defense, the Seventh Circuit made all the basic factual inquiries subsequently articulated in *Graham v. John Deere;* 383 U.S., at 17 [A-13, at 14, 15, 16, 17, 18, 19]; it showed that the most pertinent art had been cited and considered by the Patent Office [A-17]; and against that background it determined that the subject matter of the Henricks claim was not obvious [A-17,18].

5. The Henricks claim meets the statutory requirements of Sec. 112 for definiteness.

GM's contention at the trial of the validity issue, sustained by the district court, was that claim 4 was too broad and indefinite in that it did not specify the kind of phosphate coating, organic binding and solid inorganic compound, and did not specify their amounts and relative proportions [A-16].

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*In the Petition, as in the courts below, Petitioner wholly ignores the evidence of results actually achieved in commercial use of the Henricks combination and fallaciously bases its case on inferences it draws from disputed expert testimony as to comparative chemistry; this is discussed *infra,* p. 9.

The Court of Appeals, citing *Binks Mfg. Co. v. Ransburg Electro-Coating Corp.*, (7 Cir. 1960) 281 F.2d 252; cert. dismissed (1961) 366 U.S. 211; and observing that the Henricks claim "distinguishes from thirty-one references in a mature art, none of which anticipate", held that the claim complies with the requirements of Sec. 112 for definiteness [A-16,17]. GM did not and does not question the soundness or applicability of the *Ransburg* case nor does GM question the fact that the claim distinguishes from all of the art cited against it.

GM misstates the Seventh Circuit decision; contrary to GM's present assertions (Pet. p. 14), the Seventh Circuit did not "recognize" any lack of specificity in the claim, nor did it "excuse" any supposed deficiency in that regard. To the contrary, the Court of Appeals properly held that the claim need not recite details that might be varied by those skilled in the art in adapting the process to particular conditions [A-16, 17].

The petition is grossly in error in its essential factual premise (Pet. pp. 2-3) that the Henricks claim "as written, is invalid in view of the prior art * * *." The fact is that the claim distinguishes from every one of the thirty-one items of prior art cited by GM against it [A-17].

Petitioner hints that the claim covers inoperative or unworkable combinations, but neither in the Petition nor in any of the proceedings in the lower courts has defendant ever cited any supporting evidence; there is none.

ARGUMENT

—I—

(1) The decision sought to be reviewed [A-54] decides no issue of public importance. It enounces no new rules of law but simply applies settled principles to the facts of this particular case; *supra,* pp. 4, 5. The result affects no interests beyond those of the parties; *supra,* p. 1.

(2) PETITIONER'S QUESTION ONE is a contrived one that is not involved or even lurking in the decision. The Third Circuit simply looked to the unexpected results that the Seventh Circuit had held made the Henricks combination patentable [A-56] and consonant with the principle of *Graver II,* held on the basis of undisputed testimony and admitted facts [A-57, 58] that GM had achieved these results in its commercial practices; *supra,* p. 5.

GM's confusion of *results* with scientific speculations as to the nature of the chemical reactions that may take place has been noted *supra,* p. 7, fn. In disposing of GM's non-infringement arguments in that regard, the Third Circuit did not give the patent "a broader scope" (cf. Pet. p. 11 ff.) but simply held that the evidence of actual use and actual results must prevail over the disputation of chemists about the chemical interactions that occurred [A-58, 59].

The *Houdaille* decision did not limit the invention to a particular chemistry [A-57, 58]. The Seventh Circuit and Third Circuit decisions are as one in holding (i) that the new and unexpected results attained in actual practice constitute a new result that satisfies the

Sec. 101 condition; and (ii) that a process which literally responds to the claim infringes if, but only if, it achieves the results that make the process patentable; *Graver II, supra.*

(3) There is no conflict of circuits on the question of infringement of the Henricks patent; the infringement issue has been tried and decided only in the Third Circuit; *supra,* p. 5.

(4) PETITIONER'S QUESTION TWO is also a contrived one, based on non-existent premises:

(i) The Henricks claim "as written" is not "invalid in view of prior art" (cf. Pet. pp. 2-3). It distinguishes from every one of the "thirty-one references in a mature art" that were invoked against it, and there is no evidence whatsoever that it covers unworkable combinations; *supra,* p. 8: It follows that *Graver I** (Pet. p. 16) does not condemn the Henricks claim but sustains it.

(ii) The Seventh Circuit did not "rewrite" the claim (cf. Pet. p. 15) but held it valid as written because its elements (old *per se* or in other combinations) had been put together in a new way, achieving a new, unexpected and highly useful result. This suffices in law for patentability if the Sec. 103 requirement is also met, as is the case here; *supra,* pp. 6-7,

(iii) It is of no legal significance that the Henricks patent does not describe the chemical reactions which the patentee believed took place [A-58].

GM did not complain of the Seventh Circuit decision as regards any of these matters in its earlier peti-

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**Graver Mfg. Co. v. Linde Co.,* (1949) 336 U.S. 271.

tion for certiorari, denied nine years ago; 375 U.S. 971. Nothing added to the Record in subsequent proceedings strengthens Petitioner's contentions, either factually or legally.

(5) The validity decision herein [A-13] is not in conflict with *Carter-Wallace, Inc. v. Otte,* (2 Cir., 1972) 176 USPQ 2 (Pet. pp. 15-16). The patent held invalid in *Carter-Wallace* disclosed a novel organic compound which proved to be of outstanding medical importance as an anti-convulsant and a tranquilizer. The compound was claimed as a composition of matter; there was no process (or "use") claim. The trial judge, affirmed by the Court of Appeals, held the claim invalid under Sec. 103 because the compound was chemically obvious.

The trial judge took notice of the *Papesch* doctrine,* which is that "Obvious molecular modification coupled with a showing of novel [or unexpected] properties or superiority of known properties can establish patentability", but was of the view that "the discovery of novel or unexpected properties [of a chemically obvious new compound] should entitle the inventors only to a patent on the uses to be made of those properties" (176 USPQ, at 9). The Court of Appeals found it unnecessary to consider this question because "we hold, as did the court below, that the patent for meprobamate is invalid for obviousness even under the more liberal standard of Papesch" (176 USPQ, at 10). It is to be noted that even *Papesch* does not require that the unexpected property be written into the claims but only that it be disclosed in the patent application or sup-

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**Application of Papesch,* (CCPA, 1963) 315 F.2d 381.

porting documents, and that the language quoted at pages 15-16 of the Petition was used by the Court of Appeals only for the purpose of showing that the Carter-Wallace *specification* did not meet the requirements of *Papesch.*

Nothing said in *Carter-Wallace,* either decisionally or as a scholarly discussion of an open question of law,* has any bearing on the Seventh Circuit's decision [A-13] that the Henricks claim is valid: The Henricks claim is not for a composition of matter but for a process. The claim, as written, is neither anticipated nor obvious; *supra,* p. 7. The new and unexpected results achieved by Henricks demonstrated that his process was a true combination and not a mere juxtaposition; *supra,* pp. 6-7. The law has never required that the advantages of a new combination must be written into the specification; *Diamond Rubber Co. v. Consolidated Tire Co.,* (1911) 220 U.S. 428, 434, 435-36.

(6) The Seventh Circuit's validity decision herein is not in conflict with *Beckman Instruments, Inc. v. Chemtronics, Inc.,* (5 Cir., 1970) 439 F.2d 1369 (Pet. p. 16). The Clark patent held invalid in *Beckman Instruments* disclosed a device for measuring oxygen concentration in liquids or gases which was an improvement over an earlier device invented by Dr. Stow, whose work had been published and was known to Clark. Clark's most significant addition to Stow was a unique electrode (p. 1373). But the novel electrode was not included in the claims and the Fifth Circuit decision held (p. 1374) that "the patent is anticipated by prior

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**Rice v. Sioux City Cemetery,* (1955) 349 U.S. 70, 74.

art. As written, its claims include only the invention of Stow, with no novel additions".

Beckman Instruments also says (p. 1374) that "we are not required to decide whether Dr. Clark created an invention that could have been protected under a proper, lawfully secured patent[8] * * *." Footnote 8, in which the language quoted by Petitioner appears (Pet. p. 16), merely disserts upon that possibility; it does not enter at all into the actual decision; cf. *Tyrrell v. District of Columbia* (1917) 243 U.S. 1, 6.

The Henricks claim, in contrast to the claims of the Clark patent, distinguishes patentably, as written, from every one of the many items of prior art invoked against it; *supra,* p. 8.

(7) Petitioner is in error in asserting (Pet. p. 14) that the Seventh Circuit's validity decision [A-13] is "analogous" to the decision in *Noll v. O. M. Scott and Sons Co.,* (6 Cir., 1972) 467 F.2d 295, now before this Court on Petition for Certiorari, No. 72-1127. There is no similarity, factual or decisional:

The Schwerdle patent involved in *Noll* was for a method of controlling crabgrass by treating it with an arsenic compound selected from a group defined by a chemical formula written in the claim, in a concentration and amount to destroy crabgrass but insufficient to destroy the useful grasses materially. The trial court, feeling itself bound by the *Kalle** rule in the Sixth Circuit, held the patent invalid for overclaiming because the formula written in the claim embraced some compounds that were not selective between crabgrass

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**Kalle & Co. v. Multazo Co.,* (6 Cir., 1940) 109 F.2d 321; modified 110 F.2d 814.

and useful grasses in their killing effect (467 F.2d, at 298). The Court of Appeals, one judge dissenting, held that the *Kalle* rule had been modified by the 1952 codification of the patent statute, which added a new, third, paragraph to Sec. 112; and that the wording of the Schwerdle claim was sufficiently limiting under Sec. 112, as now written, to comply with the statutory requirement for definiteness (pp. 299-300).

There is nothing in the Seventh Circuit's validity decision herein [A-13] that is analogous to *Noll*. Neither the *Graver I* rule, nor the *Kalle* rule, nor the *Noll* revision thereof is apposite here because there is no evidence whatsoever that Henricks' claim 4 embraces compounds which are not effective in the practice of his process; *supra*, p. 8, p. 10. GM's argument that the Henricks claim was too broad and indefinite was of a wholly different character; *supra*, pp. 7-8. The rejection of the GM defense was in accordance with long-settled rules of law; *Binks Mfg. Co. v. Ransburg Electro-Coating Corp., supra; Minerals Separation v. Hyde,* (1916) 242 U.S. 261, 270-1; *Eibel Co. v. Paper Co.,* (1923) 261 U.S. 45, 65-6.

—II—

It is clear from the foregoing that this case does not come within the purview of Rule 19(b):

No principle, the settlement of which is of importance to the public, is involved; *Forsyth v. Hammond,* (1897) 166 U.S. 506, 513-4; *United States v. Rimer,* (1911) 220 U.S. 547, 548; *Layne & Co. v. Western Well Works,* (1923) 261 U.S. 387, 393; *Magnum Co. v. Coty,* (1923) 262 U.S. 159, 163. The only question before the court below, and the only question decided by it, was whether the evidence on infringement preponderated

toward the plaintiffs or the defendant. What Petitioner is really seeking is another review of that evidence; *Tyrrell v. District of Columbia,* (1917) 243 U.S. 1, 6; *Magnum Co. v. Coty, supra; United States v. Johnston,* (1923) 268 U.S. 220, 227.

There is no real conflict of opinion between decisions of Courts of Appeals; *Layne & Co. v. Western Well Works, supra; Keller v. Adams-Campbell,* (1924) 264 U.S. 314, 319-20. The asserted conflicts are not actual but have been fashioned by Petitioner out of judicial comments on legal questions, the resolution of which did not enter into the decisional process. That is plainly insufficient to create a conflict within the purview of Rule 19(b); *Tyrrell v. District of Columbia, supra; Rice v. Sioux City Cemetery,* (1955) 349 U.S. 70, 74.

The patent in suit has long since expired and the outcome of the litigation is of no importance to the public but only to the parties; *Forsyth v. Hammond, supra; Layne & Co. v. Western Well Works, supra; Rice v. Sioux City Cemetery, supra.*

CONCLUSION

The petition should be denied.

Respectfully submitted,

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March 22, 1973.